

### REMARKS

In response to the final Office Action of August 21, 2007, applicants ask that all claims be allowed in view of the amendment to the claims and the following remarks. Claims 1, 3-27, and 29-56 are pending in the application, with claims 1, 26, 27, and 52 being independent.

#### **Request for Withdrawal of Finality**

Claims 16-18 and 42-44 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashemi in view of U.S. Patent Application Publication No. 2003/0225847 (Heikes). However, 35 U.S.C. § 103(c) disqualifies Heikes from being used as the basis for an obviousness rejection under 35 U.S.C. § 103(a). Specifically, the present application is pending on or after December 10, 2004, Heikes only qualifies as prior art under 35 U.S.C. § 102(e), and the present application and Heikes were, at the time the invention was made, owned by, or subject to an obligation of assignment to, America Online, Inc. Consequently, 35 U.S.C. § 103(c) disqualifies the Heikes reference from being used as the basis of an obviousness rejection under 35 U.S.C. § 103(a). See MPEP § 706.02(1). Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 16-18 and 42-44, withdrawal of finality, and re-opening of prosecution on the merits. See MPEP § 706.07(a) ("When applying any 35 U.S.C. 102(e)/103 references against the claims of an application \*\* the examiner should anticipate that a statement averring common ownership at the time the invention was made may disqualify any patent or application applied in a rejection under 35 U.S.C. 103 based on 35 U.S.C. 102(e). If such a statement is filed in reply to the 35 U.S.C. 102(e)/103 rejection and the claims are not amended, the examiner may not make the next Office action final if a new rejection is made.").

#### **Claim Objections**

The Office Action objects to claims 22, 54, and 56 because of various informalities. Claims 22, 54, and 56 have been amended to address the noted issues. Applicants submit that

these amendments do not raise new issues. Accordingly, applicants respectfully request that the Examiner enter these amendments.

The Office Action also objects to claims 49-51 for improperly depending from claim 46. Applicants have amended claims 49-51 to depend from claim 48. The Office Action indicates that, for the purposes of examination, the Examiner interpreted claims 49-51 as depending from claim 48. See final Office Action of August 21, 2007 at page 2, line 18 to page 3, line 2. Therefore, applicants submit that the amendments to claims 49-51 do not raise new issues. Accordingly, applicants respectfully request that the Examiner enter these amendments.

#### **Claim Rejections Under 35 U.S.C. § 101**

Claims 27, 29-52, 55, and 56 have been rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. In particular, the Office Action asserts that "[t]he claims recite functional descriptive material because no execution of the instructions is recited." Applicants traverse this rejection. Each of independent claims 27 and 52 recites a computer program that is stored on a tangible computer readable medium and that includes various instructions, which applicants respectfully submit is statutory subject matter under 35 U.S.C. § 101. Accordingly, applicants request reconsideration and withdrawal of the rejection of independent claims 27 and 52 and dependent claims 29-51, 55, and 56, which depend from independent claim 27.

#### **Claim Rejections Under 35 U.S.C. § 102**

Claims 1, 3-6, 8-11, 19-21, 26-32, 34-37, 45-47, and 52-56 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0212804 (Hashemi). Applicants request reconsideration and withdrawal of the rejection of claims 1, 3-6, 8-11, 19-21, 26-32, 34-37, 45-47, and 52-56 because Hashemi fails to describe or suggest all of the features recited in independent claims 1, 26, 27, and 52.

#### **Claims 1, 3-6, 8-11, 19-21, 27-32, 34-37, 45-47, and 53-56**

Independent claim 1 recites a computer implemented method for sending a video clip in an instant messaging communications session. Among other features, the method includes

storing, on a host system, a collection of video clips available to be sent to instant message recipients in instant messaging communications sessions, receiving, at the host system, a request from an instant message sender for a particular video clip from among the collection of video clips stored on the host system to be delivered to the instant message recipient, and communicating the particular video clip from the host system to the instant message recipient for rendering.

Hashemi describes a peer-to-peer media clip sharing system that enables users to share pre-recorded media clips without actually transferring the file(s) in which the media clips are stored. See Hashemi at Abstract. As described by Hashemi, members of a peer group may use the media clip sharing system to designate certain media clips stored on local computers as media clips to be shared with (i.e., made available to) other members of the peer group. See, e.g., Hashemi at paragraphs [0021]-[0027] and [0038]-[0049]. Individual members of the peer group then may use the media clip sharing system to access the media clips that are stored on the local computers of other members of the peer group and that have been designated as shared by the other members of the peer group. See, e.g., Hashemi at paragraphs [0021]-[0027] and [0038]-[0049].

In particular, Hashemi describes presenting a user interface to a user that includes, among other features, a media clip browse window that indicates various media clips that are stored on the local computers of other members of the user's peer group and that have been made available to the user by the other members of the user's peer group. See, e.g., Hashemi at paragraphs [0021]-[0027] and [0038]-[0049]. In response to the user selecting a particular one of the media clips listed in the media clip browse window, the selected media clip is streamed to the user from the local computer of the member of the peer group that made the media clip available to the user. See, e.g., Hashemi at paragraphs [0021]-[0027] and [0038]-[0061].

Importantly, Hashemi describes that media clips are stored on the local computers of the members of the peer group and that media clips are streamed from the local computers of members of the peer group to the local computers of other members of the peer group. Consequently, Hashemi fails to describe or suggest storing, on a host system, a collection of video clips available to be sent to instant message recipients in instant messaging

communications sessions, and communicating a particular video clip from the host system to an instant message recipient for rendering, as recited in independent claim 1.

The Office Action contends that Hashemi discloses storing, on a host system, a collection of video clips available to be sent to instant message recipients in instant messaging communications sessions at paragraph [0058]. However, paragraph [0058] of Hashemi describes locations where lists of available media clips may be stored, not where the media clips themselves may be stored:

[0058] In one embodiment, a user computer retrieves the list [of media clips] directly from the peer computer. In another embodiment, the list of media clips may advantageously be exchanged through the central server 102, which can also be configured to store the list of media clips. One embodiment of the process further arranges the list of media clips into media clips that may advantageously be freely available to a peer and to media clips that require an additional authorization step, such as authorization through a password or through a pop-up window. For example, where a media clip requires an additional authorization step, the title of the media clip can be emphasized by shading and the like. The process advances from the seventh block 370 to an eighth block 380.

Hashemi at paragraph [0058] (emphasis added). Thus, as clearly seen from the excerpted paragraph [0058] of Hashemi, while paragraph [0058] of Hashemi describes that a list of available media clips may be stored on a peer computer or on a central server, paragraph [0058] of Hashemi does not describe where the media clips themselves actually are stored. Furthermore, as discussed above, the media clips are stored on the local computers of the members of the peer group.

Therefore, Hashemi fails to describe or suggest storing, on a host system, a collection of video clips available to be sent to instant message recipients in instant messaging communications sessions, as recited in independent claim 1. Moreover, because of this deficiency in Hashemi, it follows that Hashemi also fails to describe or suggest communicating a particular video clip from the host system to an instant message recipient for rendering, as recited in independent claim 1.

Hashemi also fails to describe or suggest receiving, at a host system, a request from an instant message sender for a particular video clip from among the collection of video clips stored on the host system to be delivered to an instant message recipient, as recited in independent claim 1. The Office Action cites paragraph [0027] of Hashemi as describing this feature of independent claim 1 because paragraph [0027] of Hashemi discloses that "[t]he exemplary user computer 130 can also send a stream of a media clip to another user computer." Final Office Action of August 21, 2007 at page 4, lines 18-22; Hashemi at paragraph [0027]. However, as described by Hashemi, such a stream of a media clip is sent from the exemplary user computer to the other user computer in response to a user of the other user computer requesting that the stream of the media clip be sent to the other user computer. For example, Hashemi describes that "[a] media clip selection module 136 permits a user to select which media clips from a list of media clips may be received in a stream from another user computer." Hashemi at paragraph [0025]. Because Hashemi describes sending a stream of a media clip from an exemplary user computer to another user computer in response to a user of the other user computer requesting that the stream of the media clip be sent to the other user computer, Hashemi fails to describe or suggest receiving, at a host system, a request from an instant message sender for a particular video clip from among the collection of video clips stored on the host system to be delivered to an instant message recipient, as recited in independent claim 1.

Accordingly, for at least the foregoing reasons, applicants request reconsideration and withdrawal of the rejection of independent claim 1 and its dependent claims, claims 3-6, 8-11, 19-21, 53, and 54.

Independent claim 27 recites features similar to those discussed above in connection with independent claim 1 and does so in the context of a computer program stored on a tangible computer readable medium. Therefore, for at least the reasons discussed above in connection with independent claim 1, applicants request reconsideration and withdrawal of the rejection of independent claim 27 and its dependent claims, claims 28-32, 34-37, 45-47, 55, and 56.

#### Claims 26 and 52

With respect to independent claim 26, the Office Action asserts only that "[c]laim 26 recites a method with substantially the same limitations as the method of claim 1. Therefore, the

claims are rejected under the same rationale.” Final Office Action of August 21, 2007 at page 8, lines 2-3.

However, applicants submit that the subject matter recited in independent claim 26 differs from the subject matter recited in independent claim 1. For example, independent claim 26 recites the following features that are not recited in independent claim 1: rendering, on an instant messaging recipient system associated with an instant message recipient, an instant messaging application user interface for an instant messaging communications session involving at least the instant message recipient and an instant message sender, receiving an instant message that includes a video clip identifier corresponding to a selected video clip to be displayed by the instant messaging recipient system, automatically accessing the selected video clip in response to receiving the instant message that includes the video clip identifier corresponding to the selected video clip, and rendering the accessed video clip at the instant messaging recipient system.

Moreover, as with independent claim 1, Hashemi fails to describe or suggest all of the features recited in independent claim 26. As discussed above, Hashemi describes a user interface that is presented to a user and that includes, among other features, a media clip browse window that indicates various media clips that are stored on the local computers of other members of the user's peer group and that have been made available to the user by the other members of the user's peer group. See, e.g., Hashemi at paragraphs [0021]-[0027] and [0038]-[0049]. In addition, Hashemi describes that the user interface also may include a chat window that enables the user to chat with other members of the peer group while a media clip is being streamed to the user, thereby enabling the user to discuss various different aspects of the media clip with other members of the peer group as the media clip is streamed to the user. See, e.g., Hashemi at paragraphs [0021]-[0027] and [0038]-[0049].

However, Hashemi does not describe or suggest receiving an instant message that includes a video clip identifier corresponding to a selected video clip to be displayed by the instant messaging recipient system, as recited in independent claim 26. In rejecting independent claim 1, the Office Action contends that Hashemi discloses a video clip identifier corresponding to a selected video at paragraph [0081] because Hashemi describes that “[t]he File Reference field 616 can contain information such as a filename and path for the corresponding media clip on the user computer identified in the Peer Computer Reference field 612” and the Office Action

also contends that because "a media clip identifier inherently must be sent to the instant message recipient." Hashemi at paragraph [0081] and final Office Action of August 21, 2007 at page 5, lines 3-6.

As an initial matter, applicants submit that Hashemi does not suggest that a media clip identifier inherently must be sent to the instant message recipient. As discussed above, Hashemi describes streaming a media clip from the local computer of one member of a peer group to the local computer of another member of the peer group. However, Hashemi does not describe that the streaming of a media clip from the local computer of one member of a peer group to the local computer of another member of the peer group involves the sending of a media clip identifier (or anything else besides the media clip itself for that matter), nor is the sending of a media clip identifier necessarily inherent in the streaming of a media clip from the local computer of one member of a peer group to the local computer of another member of the peer group.

Furthermore, even assuming for the sake of argument only that the sending of a media clip identifier is inherent in Hashemi's disclosure of streaming a media clip from the local computer of one member of a peer group to the local computer of another member of the peer group, the implication would seem to be that the media clip identifier would be included in the data streamed from the local computer of the one member of the peer group to the local computer of the other member of the peer group. Notably, Hashemi does not describe, nor is there anything to suggest, that such a media clip identifier would be sent in an instant message. Consequently, Hashemi fails to describe or suggest receiving an instant message that includes a video clip identifier corresponding to a selected video clip to be displayed by the instant messaging recipient system, as recited in independent claim 26. Accordingly, for at least this reason, applicants request reconsideration and withdrawal of the rejection of independent claim 26.

Independent claim 52 recites features similar to those discussed above in connection with independent claim 26 and does so in the context of a computer program stored on a tangible computer readable medium. Therefore, for at least the reasons discussed above in connection with independent claim 26, applicants request reconsideration and withdrawal of the rejection of independent claim 52.

### **Claim Rejections Under 35 U.S.C. § 103**

#### Claims 7 and 33

Claims 7 and 33, which depend from independent claims 1 and 27 respectively, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashemi in view of U.S. Patent No. 5,919,247 (Van Hoff). However, Van Hoff does not cure the deficiencies in Hashemi noted above, nor does the Office Action contend that Van Hoff does so. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 7 and 33 at least because of their dependencies and the reasons discussed above in connection with independent claims 1 and 27.

#### Claims 9 and 35

Claims 9 and 35, which depend from independent claims 1 and 27 respectively, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashemi in view of U.S. Patent Application Publication No. 2002/0049717 (Routtenberg). However, Routtenberg does not cure the deficiencies in Hashemi noted above in connection with independent claims 1 and 27, nor does the Office Action contend that Routtenberg does so. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 9 and 35 at least because of their dependencies and the reasons discussed above in connection with independent claims 1 and 27.

#### Claims 12-15 and 38-41

Claims 12-15 and 38-41, each of which depends from one of independent claims 1 and 27, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashemi in view of U.S. Patent No. 6,070,171 (Snyder). However, Snyder does not cure the deficiencies in Hashemi noted above in connection with independent claims 1 and 27, nor does the Office Action contend that Snyder does so. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 12-15 and 38-41 at least because of their dependencies and the reasons discussed above in connection with independent claims 1 and 27.



Claims 16-18 and 42-44

Claims 16-18 and 42-44 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashemi in view of U.S. Patent Application Publication No. 2003/0225847 (Heikes). However, as discussed above, 35 U.S.C. § 103(c) disqualifies Heikes from being used as the basis for an obviousness rejection under 35 U.S.C. § 103(a). Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 16-18 and 42-44, withdrawal of finality, and re-opening of prosecution on the merits.

Claims 22-25 and 48-51

Claims 22-25 and 48-51, each of which depends from one of independent claims 1 and 27, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashemi in view of Yubing Wang et al., Video: An Empirical Study of RealVideo Performance Across the Internet (Wang). However, Wang does not cure the deficiencies in Hashemi noted above in connection with independent claims 1 and 27, nor does the Office Action contend that Wang does so. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 22-25 and 48-51 at least because of their dependencies and the reasons discussed above in connection with independent claims 1 and 27.

**Examiner's Response to Applicants' Previous Remarks**

Applicants note that the Office Action indicates that the phrase tangible computer readable medium "will be interpreted as comprising only tangible mediums such as 'a disc, a client device, a host device' by not intangible mediums such as 'a propagated signal.'" Final Office Action of August 21, 2007 at page 14, lines 4-7. Applicants submit that it is the actual claim language that defines the metes and bounds of the claims and, as such, applicants do not acquiesce to any construction of the phrase tangible computer readable medium that is limited only to the examples of tangible computer readable media enumerated by the Office Action. Rather, applicants submit that the term tangible computer readable medium is to be construed to include all forms of tangible computer readable media.

Furthermore, in response to the Office Action's characterization of applicants' remarks regarding the previously applied Morpheus reference, applicants wish to clarify that applicants

position was, and still is, that the previously applied Morpheus reference does not describe or suggest receiving, at a host system, a request from an instant message sender for a particular video clip from a collection of video clips stored on the host system to be delivered to the instant message recipient, and, in response to receiving the request for the particular video clip to be delivered to the instant message recipient, sending a video clip identifier corresponding to the particular video clip to the instant message recipient, as recited in independent claims 1 and 27, nor does the previously applied Morpheus reference describe or suggest receiving an instant message that includes a video clip identifier corresponding to a selected video clip to be displayed by the instant messaging recipient system, the video clip having been selected by the instant message sender at an instant messaging sender system as a video clip to be sent to the instant message recipient in the instant messaging communications session involving the instant message recipient and the instant message sender, as recited in independent claims 26 and 52.

#### **Conclusion**

Applicants submit that all claims are in condition for allowance.

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

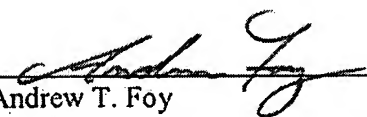
No fees are believed due. Please apply any charges or credits to Deposit Account No. 06-1050.

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Respectfully submitted,

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